

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF OHIO

THE SHERWIN-WILLIAMS COMPANY)
101 West Prospect Avenue)
Cleveland, Ohio 44115,)

Plaintiff,)

v.)

THE WOOSTER BRUSH COMPANY)
604 Madison Avenue)
Wooster, Ohio 44691,)

Defendant.)

Civil Action No.: _____

JUDGE:

Demand for Jury Trial

**COMPLAINT FOR TRADE DRESS INFRINGEMENT, DECEPTIVE TRADE
PRACTICES, AND UNFAIR COMPETITION**

INTRODUCTION

This is an action for infringement of the trade dress used in connection with The Sherwin-Williams Company's paint brushes under 15 U.S.C. § 1125(a); deceptive trade practices under O.R.C. § 4165.02; and unfair competition under Ohio common law. Sherwin-Williams owns the trade dress for the packaging of individual brushes sold under the PURDY mark, as well as the trade dress in a color code system used across its line of PURDY paint brushes. The Wooster Brush Company has infringed both.

PARTIES

1. Plaintiff, The Sherwin-Williams Company (“Sherwin-Williams”), is a corporation organized under the laws of the State of Ohio with its principal place of business in Cleveland, Ohio.

2. Defendant, The Wooster Brush Company (“Wooster”), is a corporation organized under the laws of the State of Ohio with its principal place of business in Wooster, Ohio.

JURISDICTION AND VENUE

3. This Court has jurisdiction because: (a) this is an action brought under the Trademark Laws of the United States (15 U.S.C. §§ 1051, *et seq.*), jurisdiction being conferred in accordance with 15 U.S.C. § 1121 and 28 U.S.C. §§ 1331, 1338(a), and 1338(b); and (b) this action includes claims that are so related to claims within such original jurisdiction that they form part of the same case or controversy, supplemental jurisdiction being conferred in accordance with 28 U.S.C. § 1367.

4. Venue is proper in this Court under 28 U.S.C. § 1391(b).

FACTS

Sherwin-Williams And Its Brush Keeper Trade Dress and Color Code Trade Dress

5. Since at least as early as 1925, Sherwin-Williams and its predecessors have manufactured, marketed, and sold high-quality painting tools, including paint brushes, to professional painters and do-it-yourself consumers.

6. Sherwin-Williams sells its paint brushes in paint supply stores and home improvement stores, including “big box” stores such as Home Depot and Lowes.

Sherwin-Williams’ Brush Keeper Trade Dress

7. Since the 1970s, Sherwin-Williams has used a distinctive design on its product package, also known as a “brush keeper,” in which it has marketed and sold its paint brushes throughout the United States.

8. Since at least as early as 2010, Sherwin-Williams has used the following brush keeper packaging for the PURDY-branded paint brushes, shown below, as well as similar packaging for other brushes in the PURDY line:



9. Sherwin-Williams' product packaging trade dress includes the following elements:

- a distinctive shade of golden yellow as the background color;
- a small, partial image of the American flag, located at the very top and center of the brush keeper;
- a thick horizontal color band based on the Color Code Trade Dress (as defined below) going all the way across the brush keeper, approximately one-third of the way down the front of the brush keeper;
- the brand name ("PURDY") in large font on the top one-third of the brush keeper;
- a description of the type of brush bristle (*e.g.*, nylon/polyester, 100% dyed nylon, 100% natural white bristle, etc.) in a smaller font beneath the brush name, located inside the thick horizontal band of color; and

- a description of the type of paint for which the brush is designed (*e.g.*, all paints and stains, latex paints, oil-based paints, stains and clears, etc.) in font roughly the same size as the font used to designate the type of brush bristle, located beneath the thick horizontal band of color

(collectively, the “Brush Keeper Trade Dress”).

10. Sherwin-Williams' Brush Keeper Trade Dress is unique in the painting tool industry and constitutes an inherently distinctive trade dress.

11. Sherwin-Williams' Brush Keeper Trade Dress is not functional because it is not essential to the use or purpose of the paint brush, it does not affect the cost or quality of the paint brush, and Sherwin-Williams' exclusive use of the Brush Keeper Trade Dress does not put Wooster, or any other competitor of Sherwin-Williams, at a non-reputation related disadvantage in the marketplace.

Sherwin-Williams' Color Code Trade Dress

12. Since at least as early as 2000, Sherwin-Williams has used a color coding system on its brush keeper packaging to identify each type of brush in the PURDY line.

13. The color code trade dress consists of an arbitrarily chosen color for each type of brush in the PURDY line, namely:

- (a) the color brown signifies a nylon/polyester blended bristle brush;
- (b) the color green signifies a 100% nylon bristle brush;
- (c) the color light blue signifies a white China bristle brush;
- (d) the color red signifies a black China bristle brush;
- (e) the color blue signifies a nylon/Chinex® nylon/polyester blended bristle brush;
- (f) the color purple signifies an ox-hair bristle brush; and
- (g) the color orange signifies a nylon/Chinex® nylon blended bristle brush

(collectively, "Color Code Trade Dress").

14. Sherwin-Williams' Color Code Trade Dress is unique in the painting tool industry and constitutes an inherently distinctive trade dress.

15. Sherwin-Williams' Color Code Trade Dress is not functional because it is not essential to the use or purpose of the paint brush, it does not affect the cost or quality of the paint brush, and Sherwin-Williams' exclusive use of the Brush Keeper Trade Dress does not put Wooster, or any other competitor of Sherwin-Williams, at a non-reputation related disadvantage in the marketplace.

**Sherwin-Williams' Marketing and Sales of Paint Brushes
Bearing the Brush Keeper Trade Dress and Color Code Trade Dress**

16. Sherwin-Williams has sold hundreds of millions of dollars worth of paint brushes bearing its Brush Keeper Trade Dress and Color Code Trade Dress.

17. Sherwin-Williams has spent millions of dollars advertising its paint brushes sold bearing the Brush Keeper Trade Dress and the Color Code Trade Dress.

18. As a result of Sherwin-Williams' extensive sales and advertising of paint brushes bearing the Brush Keeper Trade Dress and Color Code Trade Dress, the paint industry and its consumers recognize them as indicators of the products' source. The Brush Keeper Trade Dress and Color Code Trade Dress have acquired secondary meaning and have come to represent an extremely valuable goodwill that Sherwin-Williams now owns.

**Wooster's Use Of Infringing Brush Keeper Packaging Trade Dress
And Infringing Color Code Trade Dress**

19. Wooster manufactures, markets, and sells painting tools, including paint brushes that compete with Sherwin-Williams' PURDY paint brushes.

20. On information and belief, in stores other than Home Depot, Wooster has sold and continues to sell its paint brushes using several types of packaging trade dress, including

those shown below, that do not infringe Sherwin Williams' Brush Keeper Trade Dress and Color Trade Dress:



21. Upon information and belief, in 2012 Wooster changed the packaging trade dress it used for its WOOSTER PRO brushes sold at Home Depot to closely imitate Sherwin-Williams' Brush Keeper Trade Dress and Color Code Trade Dress. At the time Wooster

changed its packaging trade dress, Sherwin-Williams had used its Brush keeper Trade Dress and Color Code Trade Dress for well over 10 years.

22. The following are examples of WOOSTER PRO paint brushes sold at Home Depot:



23. Wooster's infringing trade dress includes the following elements:

- a golden yellow background color for the upper one-third of the brush keeper;
- a small, partial image of the American flag, located at the very top and center of the brush keeper;
- a thick horizontal band of color—which color corresponds to the color used by Sherwin-Williams under its Color Code Trade Dress for the same brush type—located across the brush keeper approximately one-third of the way down the front of the brush keeper;
- the brand name in large font on the top one-third of the brush keeper;
- a description of the type of brush bristle (e.g., nylon/polyester, 100% nylon, white China bristle, etc.) in a smaller font beneath the brand name, located inside the above-described thick diagonal band of color; and
- a description of the type of paint for which the brush is designed (e.g., all paints and stains, oil-based paints and stains, etc.) in font roughly the same size as the font used to designate the type of brush bristle, located beneath the above-described thick diagonal band of color

(collectively, the “Infringing Brush Keeper Trade Dress”).

24. Home Depot displays WOOSTER PRO paint brushes bearing the Infringing Brush Keeper Trade Dress side-by-side in the same displays with Sherwin-Williams' PURDY paint brushes bearing the Brush Keeper Trade Dress and Color Code Trade Dress, as shown below:



25. Home Depot also sells both WOOSTER PRO brushes bearing the Infringing Trade Dress and PURDY brushes bearing the Brush Keeper Trade Dress and Color Code Trade Dress through its website located at www.homedepot.com ("Home Depot Web Site"). *See* Exhibit A.

26. By using the "compare" feature on the Home Depot Web Site, consumers can select up to four brushes to view side-by-side. This feature allows consumers to view Wooster's WOOSTER PRO paint brushes bearing the Infringing Brush Keeper Trade Dress directly next to

Sherwin-Williams' PURDY brushes bearing the Brush Keeper Trade Dress and Color Code Trade Dress.

27. For brushes it currently sells at Home Depot, Wooster uses the color brown to signify nylon/polyester blended bristle brushes. Under its Color Code Trade Dress, and long prior to such use by Wooster, Sherwin-Williams has used the color brown to signify its nylon/polyester blended bristle brushes. At Home Depot stores and on the Home Depot Web Site, Wooster's and Sherwin-Williams' nylon/polyester brushes use the trade dress shown below, respectively:



28. For brushes it currently sells at Home Depot, Wooster also uses the color green to signify 100% nylon bristle brushes. Under its Color Code Trade Dress, and long prior to such use by Wooster, Sherwin-Williams has used the color green to signify its 100% nylon bristle brushes. At Home Depot stores and/or on the Home Depot Web Site, Wooster's and Sherwin-Williams' 100% nylon brushes use the trade dress shown below, respectively:



29. For brushes it currently sells at Home Depot, Wooster uses the color light blue to signify white China bristle brushes. Under its Color Code Trade Dress, and long prior to such use

by Wooster, Sherwin-Williams has used the color light blue to signify its white China bristle brushes. At Home Depot stores and/or on the Home Depot Web Site, Wooster's and Sherwin-Williams' white China bristle brushes use the trade dress shown below, respectively:



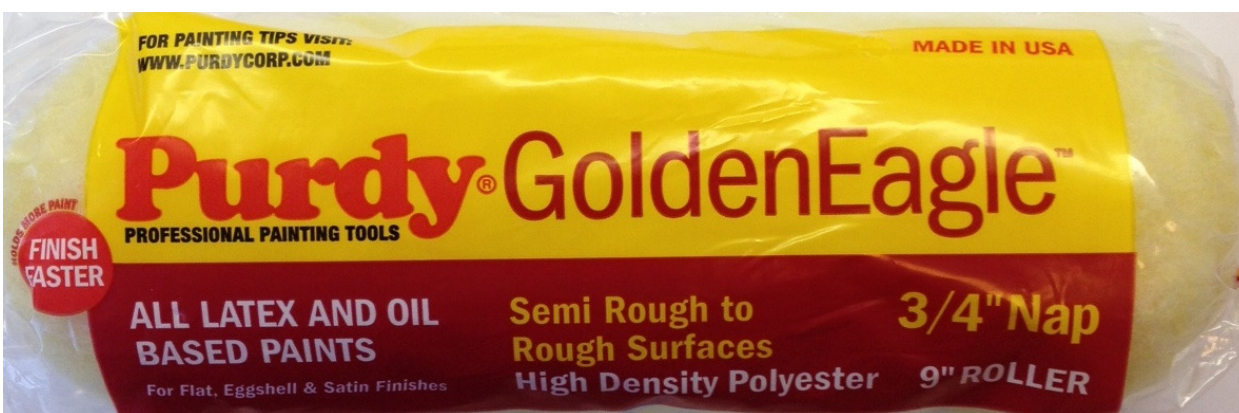
Wooster's Bad Faith Intent To Trade Off Of Sherwin-Williams' Goodwill

30. For brushes it currently sells at Home Depot and on the Home Depot Web Site, Wooster uses violet to signify Chinex® bristle brushes. In its 2011 catalog, and prior to such use by Wooster, Sherwin-Williams used a similar shade of violet to signify its Chinex® bristle brushes.

31. On information and belief, Wooster started using violet to signify its Chinex® bristle brushes after Sherwin-Williams published its 2011 catalog featuring a similar shade of violet to signify its Chinex® bristle brushes.

32. Upon information and belief, Wooster adopted and began using on its WOOSTER PRO paint brushes the Infringing Brush Keeper Trade Dress, and the same colors used by Sherwin-Williams in its Color Code Trade Dress ("Infringing Color Code Trade Dress"), with full knowledge of Sherwin-Williams' prior use of, and with the bad faith intent to trade off of, Sherwin-Williams' goodwill in the Brush Keeper Trade Dress and Color Code Trade Dress.

33. Wooster also sells a line of roller covers at Home Depot in packaging that features a combination of reddish-burgundy and yellow that is very similar to the reddish-burgundy and yellow combination that Sherwin-Williams uses on its PURDY GOLDEN EAGLE roller covers, as shown below:



34. On information and belief, Wooster adopted its combination of reddish-burgundy and yellow for a line of its roller covers after Sherwin-Williams commenced use of reddish-burgundy and yellow for its PURDY GOLDEN EAGLE roller covers.

35. Wooster sells another line of roller covers at Home Depot in packaging that features a combination of blue and yellow that is very similar to the combination of blue and yellow that Sherwin-Williams uses on its PURDY WHITE DOVE roller covers, as shown below:



36. On information and belief, Wooster adopted its combination of blue and yellow for a line of its roller covers after Sherwin-Williams commenced use of its combination of blue and yellow for its PURDY WHITE DOVE roller covers.

37. Sherwin-Williams, through its predecessor, used the slogan “If it’s worth painting, it’s worth a Purdy” in connection with its paint brushes between 1998 and 2006.

38. Wooster currently uses the slogan “If it’s worth painting, it’s worth Wooster” on its packaging for paint brushes bearing the Infringing Brush Keeper Trade Dress and Infringing Color Code Trade Dress that are sold at Home Depot.

39. On information and belief, Wooster does not use the slogan, “If it’s worth painting, it’s worth Wooster” on any packaging for paint brushes other than those sold at Home Depot.

40. On information and belief, Wooster adopted the slogan, "If it's worth painting, it's worth Wooster" with knowledge that Sherwin-Williams previously used the slogan "If it's worth painting, it's worth a Purdy" in connection with its PURDY products.

41. Additionally, Sherwin-Williams uses a copper-colored ferrule on its XL line of nylon/polyester blended bristle brushes, but not on any other brushes in its PURDY line.

42. Upon information and belief, Wooster recently commenced use of a copper-colored ferrule on its nylon/polyester blended bristle brushes sold at Home Depot.

43. On information and belief, Wooster adopted the copper-colored ferrule for its nylon/polyester blended bristle brushes after Sherwin-Williams commenced use of a copper-colored ferrule for its XL line of nylon/polyester blended bristle brushes.

COUNT I
(INFRINGEMENT OF THE BRUSH KEEPER
PACKAGING TRADE DRESS UNDER 15 U.S.C. § 1125(a))

44. Sherwin-Williams re-alleges paragraphs 1 through 43 as if fully set forth herein.

45. Wooster's use of its Infringing Brush Keeper Trade Dress is likely to cause confusion, mistake, or deception in that purchasers and others are likely to assume that Wooster or the WOOSTER PRO paint brushes marketed under the Infringing Brush Keeper Trade Dress are Sherwin-Williams' paint brushes, or are sponsored by, or connected or affiliated with, Sherwin-Williams or its PURDY paint brushes.

46. Wooster's acts likely have caused or are likely to cause confusion, mistake, or deception, in violation of Section 43(a) of the United States Trademark Act, 15 U.S.C. § 1125(a).

47. Wooster's actions greatly and irreparably damage Sherwin-Williams, and will continue to cause damage unless restrained by this Court. Therefore, Sherwin-Williams is without an adequate remedy at law.

COUNT II
(INFRINGEMENT OF COLOR CODE TRADE DRESS UNDER 15 U.S.C. § 1125(a))

48. Sherwin-Williams re-alleges paragraphs 1 through 43 as if fully set forth herein.

49. Wooster's use of a color code for its WOOSTER PRO paint brushes identical to Sherwin-Williams' Color Code Trade Dress is likely to cause confusion, mistake, or deception in that purchasers and others are likely to assume that Wooster or the WOOSTER PRO paint brushes are Sherwin-Williams' paint brushes, or are sponsored by, or connected or affiliated with, Sherwin-Williams or its PURDY products.

50. Wooster's acts likely have caused or are likely to cause confusion, mistake, or deception, in violation of Section 43(a) of the United States Trademark Act, 15 U.S.C. § 1125(a).

51. Wooster's actions greatly and irreparably damage Sherwin-Williams, and will continue to cause damage unless restrained by this Court. Therefore, Sherwin-Williams is without an adequate remedy at law.

COUNT III
(DECEPTIVE TRADE PRACTICES UNDER OHIO STATUTORY AND COMMON LAW)

52. Sherwin-Williams re-alleges paragraphs 1 through 43 as if fully set forth herein.

53. Wooster's acts constitute deceptive trade practices in violation of the Ohio Deceptive Trade Practices Act, O.R.C. § 4165.02.

54. Wooster's acts greatly and irreparably damage Sherwin-Williams, and will continue to cause damage unless restrained by this Court. Therefore, Sherwin-Williams is without an adequate remedy at law.

COUNT IV
(UNFAIR COMPETITION AND TRADE DRESS INFRINGEMENT UNDER OHIO
COMMON LAW)

55. Sherwin-Williams re-alleges paragraphs 1 through 43 as if fully set forth herein.

56. Wooster's acts constitute unfair competition and trade dress infringement in violation of Ohio common law.

57. Wooster's acts greatly and irreparably damage Sherwin-Williams, and will continue to cause damage unless restrained by this Court. Therefore, Sherwin-Williams is without an adequate remedy at law.

RELIEF SOUGHT

WHEREFORE, Sherwin-Williams prays that the Court during the pendency of this case and permanently thereafter enjoin and restrain Wooster, its officers, agents, servants, employees and attorneys, as well as its successors and assigns, and all others in active concert or participation with them, from the manufacture, dealing in, marketing, sale, or distribution of products that:

(a) bear the Infringing Brush Keeper Trade Dress or the Infringing Color Code Trade Dress,

(b) bear trade dress confusingly similar to the Brush Keeper Trade Dress or Color Code Trade Dress, or

(c) bear any other trademarks or trade dress owned by Sherwin-Williams, or any trademarks or trade dress confusingly similar thereto.

Sherwin-Williams further prays that the Court require Wooster, and all others holding by, through, or under Wooster, jointly and severally, to:

(a) account for and pay over to Sherwin-Williams all profits that Wooster has derived from its acts of trade dress infringement and unfair competition in accordance with 15 U.S.C. § 1117(a);

(b) pay over to Sherwin-Williams all damages incurred by Sherwin-Williams by reason of Wooster's acts of trade dress infringement, unfair competition, and deceptive trade practices in accordance with 15 U.S.C. § 1117(a) and O.R.C. § 4165.03, and Sherwin-Williams asks that this damages award be trebled in accordance with 15 U.S.C. § 1117(a);

(c) pay to Sherwin-Williams the costs of this action, together with reasonable attorneys' fees and disbursements, in accordance with 15 U.S.C. § 1117(a);

(d) pay to Sherwin-Williams punitive damages under Ohio common law;

(e) pay to Sherwin-Williams attorneys' fees in accordance with O.R.C. § 4165.03;

(f) deliver up for destruction all labels, signs, prints, packages, wrappers, receptacles, advertisements, and products in Wooster's possession bearing the Infringing Brush Keeper Trade Dress, or any other confusingly similar trademarks or trade dress, in accordance with 15 U.S.C. § 1118;

(g) send a notice to any existing wholesale customers that the dealing in, marketing, sale, or distribution of products bearing the Brush Keeper Trade Dress or any colorable imitation thereof, or following the Color Code Trade Dress, is unlawful and that it has been enjoined by a United States District Court from doing so; and

(h) enter into the record of the Court and serve on Sherwin-Williams an affidavit setting forth in detail the manner and form in which Wooster has complied with the terms of the injunction, in accordance with 15 U.S.C. § 1116.

Sherwin-Williams further prays that the Court provide to Sherwin-Williams such other and further relief as the Court deems just and equitable.

Dated: December 14, 2012

Respectfully submitted,

/s/Hugh E. McKay

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